

REMARKS

Pursuant to the telephone conference with Examiner Kunemund on April 26, 2004, applicants respectfully request entry of the amendment.

Claims 1-92 are pending in the application. Claims 1-92 have been examined and stand rejected. Claims 93 and 94 are new and are dependent from Claim 1 to further define the apparatus.

The Rejection of Claims 1-8 and 64 Under 35 U.S.C. § 103(a)

Claims 1-8 and 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nienhaus or DeTitta et al.

Applicants respectfully call attention to the DeTitta et al. patent's filing date of April 23, 2001, which is later than the filing date of August 2, 2000, of the present application. The DeTitta et al. patent may have an effective date of April 21, 2000, based on the provisional Application No. 60/198,995. However, the present application also claims the benefit of a provisional Application No. 60/146,737, filed on August 2, 1999. Accordingly, the effective date of the present application is earlier than the DeTitta et al. patent's earliest possible effective date of April 21, 2000. Accordingly, applicants believe that the DeTitta et al. patent is not prior art.

Regarding the Nienhaus reference, applicants submit that the Nienhaus reference is directed to an apparatus using X-rays to gather information related to the structure of biological molecules. Claims 1, 63, 73, 76, 79 and 87 have been amended to recite "visible light microscopy" which excludes the X-ray range of the electromagnetic spectrum. Applicants therefore submit that the Nienhaus reference does not describe or remotely suggest the present claimed invention. Furthermore, applicants submit there is no suggestion or motivation to

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modify an X-ray crystallography apparatus, as described in the Nienhaus reference, into one using visual light microscopy since such modification would severely alter the intended purpose and completely change the principal of operation of the prior art. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); M.P.E.P. § 2143.01, pages 2100-2124. If the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

Accordingly, applicants submit that as amended, Claims 1, 64, 73, 76, 79 and 87 are allowable over the Nienhaus reference. Therefore, Claims 1-92 are allowable.

CONCLUSION

In view of the foregoing amendments, applicants respectfully submit that Claims 1-94 are allowable. If the Examiner has any further questions, the Examiner is invited to contact the applicants' attorney at the number provided below.

Respectfully submitted,

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